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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,061	05/31/2001	Kouichi Matsumura	MTS-3262US	8967

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EXAMINER

LU, KUEN S

ART UNIT PAPER NUMBER

2177

DATE MAILED: 06/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/871,061

Applicant(s)

MATSUMURA ET AL.

Examiner

Kuen S Lu

Art Unit

2177

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendments

1. The Examiner has noted the Applicants' amendments made to the Abstract and the claims, filed on February 23, 2004.

In responding to Applicants' amendments made to the Claims, filed on February 23, 2004, the Examiner has created this Office Action for Final Rejection as shown next.

As for the Applicants' REMARKS, filed on February 23, 2004, has been fully considered by the Examiner, please see discussion in the section **Response to Arguments**, following the Office Action for Final Rejection as shown next.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knee et al. (U.S. Patent 6014184, hereafter "Knee") and in view of Cragun et al. (U.S. Patent 5,859,662, hereafter "Cragun").

As per claim 16, Knee teaches the following:

"assigning by the user any arbitrary TV channel number of a remote controller the user's display to the keyword" at col. 6, lines 14-18 by utilizing a user control apparatus to choose user control commands and transmit signals in response to data processor; "storing the arbitrary TV channel number assigned in step (b) in the storage device" at col. 6, lines 14-18 by utilizing a user control apparatus to choose user control commands which is stored for further transmitting signals; "searching for broadcasting program information based on the user selecting the assigned arbitrary TV channel number on the remote controller" at col. 9, lines 61-65 by receiving information about programs or services; "matching the broadcasting channel number retrieved in step (d) with the user assigned arbitrary TV channel number in step (c)" at col. 16, lines 37-41 by displaying airing time, service indicator and channel number of a particular show, and identifying event and channel being currently broadcast at col. 6, lines 51-57; and "tuning the video receiver using the assigned arbitrary TV channel number stored in step (c) and matched in step (e)" at col. 6, lines 25-32 by using data processor to control the video display generator with video control commands, issued in response to the user control commands.

Knee does not teach means or step for inputting keywords or obtaining program information of a program relating to keyword input.

However, Cragun teaches storing at least one keyword in a storage device that characterizes a program for view at col. 2, lines 46-47 by allowing television viewer to

input to the presentation system one or more keyword to be used as search parameters.

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine Cragun's teaching into Knee's by using keypad or keyboard to input keywords for searching and matching program information because by doing so users of Knee's system could avoid scanning a huge list of program information for finding program schedule or playing a sports event in real-time. The combination would make Knee's system a subscription server to provide services to a much wider audience.

As per claim 17, Knee teaches program information server storing program information at col. 10, lines 36-40 by downloading program schedule information to a storage device; "retrieves program information of a program" at col. 15, lines 7-12 by flipping through the channels and receiving program schedule information; and "obtains said program information retrieved by said program information server" at col. 13, lines 41-44 by retrieving messages, images or programs from storage of the system.

Knee does not teach transmitting keyword and using keyword for retrieving program information.

However, Cragun teaches retrieving program information at col. 16, lines 27-31 and 39-41 by identifying the video segment and displaying to the viewer.

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine Cragun's teaching into Knee's by increasing

the capacity for storing program information and program itself and further using keywords to retrieve program information because by doing so users of Knee's system could obtain program information promptly and make Knee's system a fully functional subscribing server for multi-media.

As per claim 18, Knee teaches "comprising video recording medium control means of operating a recording medium for recording video information, wherein when programs matched with said predetermined user channel number are broadcast on plural broadcast channels" at col. 36, lines 51-55 by configuring EPG to store unique digital identifier for program and use it to transmit identified program for video recorder by automatically controlling the recorder's operation; and "video recording medium control means records programs other than at least either one of the programs on said video recording medium, and when a direction is received from said direction input means in a time period during which there is no program matched with said re-determined user channel number, said video recording medium control means reproduces said programs recorded on said video recording media" at col. 36, lines 51-55 by transmitting a unique identifier to video recorder for automatically controlling the recorder's operation and at col. 32, lines 45-49 by using virtual channels.

As per claim 19, Knee teaches the following:
"establishing, by the user, a relationship between the registered keyword and the program" at col. 16, lines 37-41 by displaying airing time, service indicator and channel number of a particular show, and identifying event and channel being currently broadcast at col. 6, lines 51-57;

"assigning, by the user, any arbitrary TV channel number of a remote controller of the user's display to the registered keyword" at col. 6, lines 14-18 by utilizing a user control apparatus to choose user control commands and transmit signals in response to data processor;

"selecting, by the user, the assigned arbitrary TV channel number on the remote controller" at col. 6, lines 14-18 by utilizing a user control apparatus to choose user control commands which is stored for further transmitting signals;

"searching for the program that is being received and stored in the storage device, based on the user selecting the assigned arbitrary TV channel number on the remote controller" at col. 9, lines 61-65 by receiving information about programs or services; and

"providing for viewing, to the user, the program searched for in step (e), after selecting the user assigned arbitrary TV channel number on the controller" at col. 6, lines 25-32 by using data processor to control the video display generator with video control commands, issued in response to the user control commands.

Knee does not teach means or step for inputting keywords or obtaining program information of a program relating to keyword input.

However, Cragun teaches "(a) registering, by the user, a keyword characterizing the program for viewing by the user" at col. 2, lines 46-47 by allowing television viewer to input to the presentation system one or more keyword to be used as search parameters.

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine Cragun's teaching into Knee's by using keypad or keyboard to input keywords for searching and matching program information because by doing so users of Knee's system could avoid scanning a huge list of program information for finding program schedule or playing a sports event in real-time. The combination would make Knee's system a subscription server to provide services to a much wider audience.

Conclusion

3. The prior art made of record

- A. U.S. Patent No. 6014184
- B. U.S. Patent 5859662

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- C. U.S. Pub. No. 2002/0126219
- D. U.S. Pub. No. 2003/0048364
- E. U.S. Patent No. 6248946
- F. U.S. Patent No. 6412111

Response to Arguments

4. The Applicants' arguments filed on February 23, 2004 have been fully considered, but they are not persuasive, for the Examiner's response, please see discussion below.

a). At Page 7, Claim 16, Applicants argued "Knee, ... does not teach ... inputting keywords or obtaining program information of a program related to a keyword

input. Cragun, ... does not disclose ... assigning any arbitrary television channel number... searching for broadcast program information, based on the user selecting the assigned arbitrary television channel number on the remote controller ... tuning a video receiver using the assigned arbitrary channel number".

As to the above argument a), the Examiner disagreed because Knee reference is introduced for its teaching on assigning arbitrary channel number (col. 6, lines 14-18), searching broadcasting program (col. 9, lines 61-65) and tuning a video receiver (col. 9, lines 25-32), while Cragun is introduced for teaching inputting keywords (col. 2, lines 46-47). Further in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

As to the newly added independent claim 19, its rejection was previously stated in the Final Office Action.

As to dependent claims 17-18 which depend on claim 16, respectively, the Examiner applies the above stated arguments for the respective claim upon which they depend.

5. In light of the forgoing arguments, the U.S.C 103 rejection for Claims 16-19 are hereby sustained.

Conclusions

6. THIS ACTION IS MADE FINAL.

The Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. The prior art made of record, listed on form PTO-892, and not relied upon, if any, is considered pertinent to applicant's disclosure.

If a reference indicated as being mailed on PTO-FORM 892 has not been enclosed in this action, please contact Lisa Craney whose telephone number is (703) 305-9601 for faster service.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuen S Lu whose telephone number is 703-305-4894. The examiner can normally be reached on 8 AM to 5 PM, Monday through Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on 703-305-9790. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Kuen S. Lu


Patent Examiner


SRIRAMA CHANDRA JALA
PRIMARY EXAMINER

June 8, 2004